

REMARKS

This reply is submitted under Rule 115 (37 C.F.R. § 1.115). The following comments are included in accordance with Rule 111 (37 C.F.R. § 1.111).

A petition for a three-month extension of time under Rule 136(a) (37 C.F.R. § 1.136(a)) accompanies this reply. Accordingly, the period for reply extends through July 7, 1998.

Claims 1-40 are pending in the present application. In the January 7, 1998 Office Action, the Primary Examiner rejected pending claims 1-11 on the ground of estoppel. Additionally, the Primary Examiner rejected pending claims 12-40 under 35 U.S.C. § 103 as being unpatentable as obvious in view of the disclosure in Meer, et al., U.S. Patent No. 5,177,107 (hereafter referred to as "the Meer, et al. patent").

Claims 1-11 stand rejected on the ground of estoppel. Reconsideration of the rejection of claims 1-11 on the ground of estoppel is respectfully requested for the following reasons.

Although the declaration under Rule 175(a) (37 C.F.R. § 1.175(a)) filed in connection with the present application states that the Applicant "believes" that claims 1-11 are unpatentable, the fact is that claims 1-11 were filed in the application for examination by the United States Patent and Trademark Office and the appropriate claim fee was paid. The United States Patent and

Trademark Office was therefore charged to examine claims 1-11 to determine whether or not claims 1-11 are patentable, notwithstanding the "belief" stated by the Applicant in the reissue application declaration. Clearly, claims 1-11 would not have been included in the present application if the Applicant held the conviction that claims 1-11 were without question unpatentable. Since the very presence of claims 1-11 in the present application indicates that the Applicant did not unequivocally abandon claims 1-11 based on the absolute conviction that they were unpatentable, the facts demonstrate that estoppel does not apply. Consequently, the rejection of claims 1-11 on the ground of estoppel should be withdrawn.

Claims 12-40 stand rejected as obvious in view of the disclosure in the Meer, et al. patent. Reconsideration of the rejection of claims 12-40 as obvious is respectfully requested for the following reasons.

In the Office Action mailed on January 7, 1998, the Primary Examiner states that: "Meer et al. teach a method for the control of fire ants." However, the Meer, et al. patent nowhere teaches control of fire ants with a toxic bait formulated with a vegetable oil insoluble anionic fluorochemical surfactant applied in an insecticidal concentration to a carrier in the form of a dispersible non-liquid edible food, as defined by claims 12-40. The Meer, et al. patent only discloses that an anionic

fluorochemical surfactant was formulated at a 1.0% concentration in vegetable oil and in honey/water (1:1) and tested against fire ants. See, Example 1, column 4, lines 8-15 and Example 3, column 4, lines 22-27 of the Meer, et al. patent. Consequently, the Meer, et al., patent does not disclose or suggest a vegetable oil insoluble toxicant in a toxic bait formulation for control of fire ants. Therefore, claims 12-40 are clearly allowable in view of the disclosure in the Meer, et al. patent.

Furthermore, the Applicant performed an actual comparison test between the anionic fluorochemical surfactant formulation at a 1.0% concentration in honey/water (1:1), as disclosed in the Meer, et al. patent, and the toxic bait formulated with a vegetable oil insoluble anionic fluorochemical surfactant applied in an insecticidal concentration to a carrier in the form of a dispersible non-liquid edible food, as disclosed in the present application. The results of that comparison test indicate that the formulation disclosed in the Meer, et al. patent was not effective, whereas the toxic bait formulation disclosed in the present application was very effective for the control of fire ants, as detailed on pages 5-7 of the Request for Reconsideration filed on January 17, 1997.

In the January 7, 1998 Office Action, the Primary Examiner also contends: "This reference [the Meer, et al. patent] discloses the vegetable oil-insoluble anionic fluorochemical surfactants of

the instant claims." Nonetheless, the Meer, et al. patent expressly discloses that: "Cotton swabs saturated with soybean oil containing 1.0% of a test compound were offered to the ants..." See, column 4, lines 8-9 of the Meer, et al. patent. Those "test compounds" included an anionic fluorochemical surfactant. See, the Meer, et al. patent, column 4, lines 14-15 and Table 1, Compound No. 50950. Consequently, the Meer, et al. patent suggests that the anionic fluorochemical surfactant is soluble in vegetable oil. Meer, et al. did not apparently recognize that anionic fluorochemical surfactants are insoluble in vegetable oil, in contrast to the disclosure in the present application which teaches that anionic fluorochemical surfactants are insoluble in vegetable oil.

In the Office Action mailed on January 7, 1998, the Primary Examiner also states that: "The reference [the Meer, et al. patent] teaches the necessity of impregnating granular carriers such as grits with the insecticide." The disclosure in the Meer, et al. patent has been carefully reviewed. The disclosure does not appear to mention any "necessity" of impregnating granular carriers with the insecticide. The Primary Examiner is requested to specify where in the disclosure of the Meer, et al. patent there is support for his statement.

Furthermore, the only teaching in the Meer, et al. patent regarding impregnation of granular carriers relates to baits

formulated with vegetable oil soluble toxicants. See, column 3, lines 41-49, column 4, lines 34-37, and column 5, lines 7-10 of the Meer, et al. patent. Consequently, the Meer, et al. patent discloses no formulation of a toxic bait having a granular carrier that includes other than a vegetable oil soluble toxicant. Therefore, the formulation of a toxic bait comprising a granular carrier and a vegetable oil insoluble anionic fluorochemical surfactant, as defined by claims 12-40, is nowhere disclosed or suggested by the disclosure in the Meer, et al. patent.

In the January 7, 1998 Office Action, the Primary Examiner also refers to Example 5 of the Meer, et al. patent. Specifically, the Primary Examiner states:

"In Example 5, Meer et al. teach that the insecticide may be dissolved in a volatile solvent, and the resulting mixture may be deposited on a carrier. The solvent is then permitted to evaporate, leaving the insecticidal bait behind."

However, Example 5 of the Meer, et al. patent is irrelevant for at least three reasons. First, Example 5 does not describe the use of an anionic fluorochemical surfactant as a test compound. Specifically, the Meer, et al. patent clearly discloses that all of the compounds tested in connection with Example 5 are listed in Table 5. All of the compounds listed in Table 5 are not anionic fluorochemical surfactants. Second, all of the compounds listed in Table 5 of the Meer et al. patent are sulfonamides which are soluble in vegetable oil. Moreover, the reason that the test compounds were apparently dissolved or suspended in a volatile

solvent is not described in the Meer, et al. patent. Third, Table 5 clearly indicates that three of the five listed compounds (Compounds No. 29756, 29757, and 29758) did not demonstrate insecticidal efficacy.

The Primary Examiner also contends that the insecticide may be "dissolved" in a volatile solvent. However, the Meer, et al. patent expressly discloses that the only "solvents" used in connection with an anionic fluorochemical surfactant are vegetable oil (for example, Example 1 and Table 1 of the Meer, et al. patent) and "a 1:1 v/v mixture of honey and water (Example 3 and Table 3 of the Meer, et al. patent). The only example of the apparent use of a non-aqueous solvent disclosed in the Meer, et al. patent is Example 5 and Table 5 relating to sulfonamides which are not anionic fluorochemical surfactants and which are soluble in vegetable oil. In fact, the disclosure in the Meer, et al. patent does not support the use of acetones and alcohols as solvents for a toxicant used in a solid bait. Moreover, Example 5 expressly reads:

"The bait was prepared by adding 10 ml of a solution or suspension of the test compound in a volatile solvent to 10 g of fly food in a small container." Meer, et al. patent, column 4, lines 55-57. (Emphasis supplied.)

Therefore, the Meer, et al. patent expressly discloses that a suspension of a test compound in a volatile solvent may be used instead of a solution of a test compound in a volatile solvent.

Furthermore, a non-aqueous solvent was not used in Example 5 because the test compound was an anionic fluorochemical surfactant which is insoluble in vegetable oil, since the compounds in Table 5 used in Example 5 are vegetable oil soluble. In fact, a non-aqueous solvent was used to prevent wetting and subsequent spoilage of the fly food (sugar, powdered nonfat dry milk, and powdered egg yolk). Specifically, the Amendment filed on December 5, 1994 in the Vander Meer, et al. patent application in the interference proceeding, whose disclosure is substantially the same as the disclosure in the Meer, et al. patent, expressly states:

"Moreover, applicants submit that those skilled in the art would know not to use an aqueous solvent to apply an active ingredient to dehydrated materials, such as powdered nonfat dry milk and powdered egg yolk. The use of water on such materials would cause nonuniform swelling of the particles and uneven distribution of the active ingredient. Furthermore, the use of water with the materials listed in Example 5 would likely lead to a material having the consistency of syrup which would be difficult or impossible to pulverize."

The test compounds in Example 5 did not require the use of a volatile solvent as the Primary Examiner contends. Rather, the fly food dictated the use of a volatile solvent. Also, the Meer, et al. patent does not disclose adding a sufficient amount of any type of a dissolved anionic fluorochemical surfactant to thereby moisten the carrier as recited, for example, in claim 12 of the present application. Consequently, the contention by the Primary Examiner that the Meer, et al. patent discloses the use of non-aqueous

solvents for dissolving a vegetable oil insoluble anionic fluorochemical surfactant is without merit. Therefore, the toxic bait formulation defined by claims 12-40 is clearly allowable in view of the disclosure in the Meer, et al. patent.

In view of the foregoing remarks, it is respectfully submitted that the Primary Examiner has not presented a *prima facie* case of obviousness with respect to claims 12-40 in view of the disclosure in the Meer, et al. patent. Furthermore, the following statement by the Primary Examiner appears to inadvertently concede that the toxic bait formulation defined by claims 12-40 is nonobvious: "It would appear that Applicant has reversed the steps in which the insecticidal bait is prepared (impregnating the carrier with the insecticide and then adding the soybean oil, as opposed to dissolving the insecticide in soybean oil and impregnating the carrier with the resulting mixture)." First, it should be noted that not all of claims 12-40 recite addition of soybean oil, so this step is not "reversed," but is missing entirely. Second, and more importantly, anionic fluorochemical surfactants are vegetable oil insoluble, so there is clearly no step of dissolving the anionic fluorochemical surfactant in soybean oil.

Finally, the Primary Examiner invites the Applicant to submit evidence demonstrating that Applicant's composition is unexpectedly superior, in kind or degree, to the composition disclosed in the Meer, et al. patent. Submitted herewith is a true copy of the

Declaration of Sanford D. Porter Under Rule 132 (37 C.F.R. § 132) (hereafter referred to as "the Porter Declaration") filed in connection with the parent of the application which issued as the patent that forms the basis of this reissue application. Insofar as is relevant, the disclosure in the Vander Meer, et al. paper cited in the first Office Action and referred to in the Porter Declaration is substantially the same as the disclosure in the Meer, et al. patent with respect to the compositions containing an anionic fluorochemical surfactant. Paragraphs 26 and 27 of the Porter Declaration detail the unexpected results obtained by an independent public testing agency. Specifically, Dr. Porter concludes:

"The high mortality rates which I obtained during tests of the vegetable oil insoluble surfactant (sulfonate) toxicant disclosed in the patent application of Mr. Milks are clearly unexpected in view of Vander Meer, et al., 1985." Porter Declaration, p. 13. (Emphasis supplied.)

Consequently, unexpected results were obtained when the toxic bait formulation in accordance with claims 12-40 was tested against fire ants and compared to the test data for the compositions disclosed in the Meer, et al. patent containing the same active ingredient (anionic fluorochemical surfactant). It is therefore respectfully submitted that even if a *prima face* case of obviousness has been presented by the Primary Examiner, this has been overcome by evidence of unexpected results produced by an independent testing agency. Consequently, the rejection of claims 12-40 should be

withdrawn.

For the foregoing reasons, it is respectfully submitted that claims 12-40 are allowable in view of the disclosure in the Meer, et al. patent, as well as the disclosures in the other references of record, whether those disclosures are considered singly or in combination. Therefore, a notice of allowance is earnestly solicited.

Respectfully submitted,

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